

REMARKS

The Applicants thank the Examiner for his examination of the subject application thus far. The applicant submits that the claims, as amended, are patentable over the cited prior art for the following reasons:

Claims 1, 2, 5-8, 10, 11, and 14-17 are patentable over the cited art

In the Office Action dated December 27, 2007 (the "Detailed Action"), the Examiner rejected claims 1, 2, 5-8, 10, 11, and 14-17 under 35 U.S.C. 103(a) as being unpatentable over Schmidt, Jr. et al. (US6778642) ("Schmidt, Jr.") in view of Gidwani (US6640239) ("Gidwani"). The Applicants respectfully traverse this rejection.

First, the Applicants note that in the previous Office Action of September 27, 2007, the Examiner had rejected all claims as being unpatentable over Schmidt, Jr. in view of Gidwani, and Hwang (US5781857). The Applicants had not amended the claims in response to the September 27, 2007 Action. It therefore appears that in *this* Detailed Action, then, that no *prima facie* case of obviousness has been made out. The Examiner clearly indicated in the September 27, 2007 Action that additional art was required to supplement a combination of Schmidt, Jr. and Gidwani in order to support a rejection of claims 1, 2, 5-8, 10, 11, and 14-17 under 35 U.S.C. 103(a) (which the Applicants traversed). Now, in the December 27, 2007 action, this additional art is omitted. It therefore follows logically that not every element of the pending claims as of December 27, 2007 was taught or suggested by the prior art cited in the instant Detailed Action. All claim limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention: *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). On this basis, therefore, the Applicants submit that claims 1, 2, 5-8, 10, 11, and 14-17 are patentable over the cited art.

In the present amendment, however, the Applicants have amended independent claims 1 and 10 as follows:

1. A program product for execution on a communications device for receiving, storing and displaying heterogeneous messages from different communications channels, the messages being

received via different communications channels being received in formats specific to each communications channel,

the communications device being capable of executing a plurality of message applications, each message application being associated with one of the communications channels and being executable to store and display messages received from the associated communications channel,

the program product comprising a medium having executable program code embodied in said medium, the executable program code comprising a collating application,

the executable program code comprising a collating application being executable on the communications device for dynamically retrieving heterogeneous messages stored by the plurality of message applications, said retrieved messages meeting at least one collating criterion, and for displaying on a user interface of the communications device an ordered listing of message body fragments associated with at least one of said retrieved messages in a single view on the communications device, the application further executable, while the application is displaying on the user interface, to continually retrieve messages as they are received and stored by each of the communications channels and to display retrieved messages that match the at least one collating criterion, the retrieved collated messages then incorporated into the application's display.

10. A method for a communications device to display a listing of heterogeneous messages, the communications device being capable of executing a plurality of message applications, each message application being associated with one of a plurality of communications channels and being executable to store and display messages received from the associated communications channel, the method comprising the steps of

displaying, by a collating application and at the user interface of the communications device, a single view comprising an ordered list of message body fragments from a plurality of heterogeneous messages, the message body fragments extracted from messages associated with the plurality of communications channels, the messages selected using at least one collating criterion;

continually selecting, using the at least one collating criterion, messages as they are received and stored by each of the communications channels while the collating application continues to display the single view at the user interface;

updating the single view display comprising an ordered list, by the collating application, by updating the ordered list using message body fragments derived from the continually selected messages.

These amendments were made to address suggestions made by the Examiner (see pages 8-9 of the Detailed Action). Notwithstanding the insufficiency of the cited prior art, as explained above, the Applicants submit that the claims, as amended, are patentable over Schmidt, Jr. in view of Gidwani. Further clarifying amendments were also made to the dependent claims.

Schmidt, Jr. does not disclose the subject matter it is said to disclose: In the Detailed Action, page 3, it is concluded that Schmidt, Jr., and in particular column 5, lines 26-37, discloses:

the communications device being capable of executing a plurality of message applications, each message application being associated with one of the communications channels and being executable to store and display messages received from the associated communications channel,

However, the cited passage of Schmidt, Jr. does not disclose any “communication device being capable of executing a plurality of message applications”. Column 5, lines 26-29 of Schmidt, Jr. describe that:

... a user may use telephone 320 to dial into UMS server 340 via PSTN 360 to leave a voice mail for another user. In addition, a user may retrieve email messages or facsimile messages using the client 310.

In the Detailed Action, it was stated that “it is clear that these different messages [in Schmidt, Jr.] inherently require different functionality to process each correctly (i.e. fax message requires different protocol than an email message) in order for the user [to completely and efficiently] interact with the system” (page 3). The Applicants traverse this finding. To establish the inherency of an element that is lacking in the cited art, the *necessity* of that element must be proven; it is not enough to suggest that it is desirable or possible for an element to be implemented, for example for the purposes of efficiency, to make that element *inherent*. If the element is not necessarily present in the prior art, then it is not inherent in the prior art: see *MEHL/Biophile Int'l Corp. v. Milgram*, 192 F.3d 1362, 1365 (Fed. Cir. 1999). Therefore, on this further basis, the cited prior art does not disclose each and every element of claims 1, 2, 5-8, 10, 11, and 14-17; therefore, it is submitted that these claims are patentable over the cited art.

Neither Schmidt, Jr. nor Gidwani discloses “an ordered listing of message body fragments”: amended claims 1 and 10 recite “an ordered listing of message body fragments”. The Applicants submit that this feature is not disclosed in the cited prior art. In the response to the Applicants’ previous arguments (Detailed Action, page 8), it was stated that “a complete message contains for example (subject or title or header) and body, therefore by displaying the subject a fragment of the complete message is displayed”. By this amendment, it is clarified that the message fragment is a “message body fragment”, which by the Examiner’s suggested definition is *not* a subject, title, or header. Therefore, claims 1 and 10 recite subject matter that is not disclosed by the cited prior art, and again there is consequently no *prima facie* case of obviousness against these claims. Since the cited art fails to render any of the independent claims obvious, all the dependent claims are nonobvious as well: *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Gidwani does not disclose “dynamically retrieving heterogeneous messages” or “to continually retrieve messages as they are received and stored by each of the communications channels”: In the Detailed Action (pages 3–4), it is stated that “Gidwani discloses an apparatus and method for intelligent scalable switching network and further discloses an interface with heterogeneous messages and collating them which provides a type of collating application in the system (Column 49, Lines 52–65)”. However, the Applicants submit that Gidwani does *not* disclose “dynamically retrieving heterogeneous messages”, or “to continually retrieve messages as they are received and stored by each of the communications channels.”

In the Detailed Action, the Examiner suggested that “dynamic function merely means that a program is not static and by allowing retrieval of the messages a dynamic function is performed” (Detailed Action, page 8). In other words, the suggested definition of “dynamic” in the context of a program is that it is doing something. The Applicants submit that in the context of the present application, a person skilled in the art would understand that “dynamically retrieving...” is a function involving updating without user intervention: see, for example, paragraphs [0036] and [0037] of the application as originally filed:

As is shown in the example, when a new message matching the collating criteria is received by the communication device, there is a change to the icon on the screen to indicate the receipt of the new message...

The change of screen 50 to modify icon 52 by replacement with icon 56 is dynamically carried out without user intervention or action. (emphasis added)

To further clarify the subject matter of the claims, the Applicants have amended independent claims 1 and 10 to indicate the “continually retriev[ing]” (claim 1) and the “continually selecting” and “updating” (claim 10) activity, “while the [collating] application is displaying [or continues to display]” on a user interface. The cited passage of Gidwani does not identify such a dynamic, updating function. Accordingly, the Applicants submit that the claims, as amended, are patentable over the cited art, alone or in combination.

Claims 3, 4, 12, and 13 are patentable over the cited art

The Examiner rejected claims 3, 4, 12, and 13 under 35 U.S.C. 103(a) as being unpatentable over Schmidt, Jr. in view of Gidwani, and further in view of Dong et al. (US6571275) (“Dong”). The Applicants respectfully traverse this rejection.

No proper basis has been given for the alleged combination of Dong with Schmidt, Jr. and/or Gidwani. In the Detailed Action, it is stated that “[o]ne would have been motivated to provide an address book to provide improved query of names, groups, etc.” (page 6); however, this rationale is so general that it could be applied to just about any reference, and has no application to the specific technical considerations of the current application. A motivation to combine references must *clearly and particularly* lead a person of ordinary skill in the art to make the combination (see *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 660 (Fed. Cir. 200)). In the present Detailed Action, the fact that address books are apparently desirable in general is not proof that a skilled worker in the field would have combined the teachings of Dong with those of Schmidt, Jr. and/or Gidwani.

Further, claims 3, 4, 12 and 13 recite, in part, “enabling a user to specify the at least one collating criterion comprises executable program code for enabling the user to specify the at least one collating criterion used to match entries in an address book maintained by the communications device”. It therefore appears that the motivation for combining Dong with Schmidt, Jr. and Gidwani was taken from the Applicants’ own disclosure. It is improper to use an applicant’s own disclosure against him: *In re Oetiker*, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

Therefore, for these reasons, the Applicants submit that claims 3, 4, 12 and 13 are patentable over the cited art, inasmuch as no proper motivation to combine the cited references has been proffered.

Claims 9 and 18 are patentable over the cited art

The Examiner rejected claims 9 and 18 under 35 U.S.C. 103(a) as being unpatentable over Schmidt, Jr. in view of Gidwani, and further in view of Schnarel et al. (US7225409) (“Schnarel”). The Applicants respectfully traverse this rejection.

No proper basis has been given for the alleged combination of Schnarel with Schmidt, Jr. and/or Gidwani. In the Detailed Action, it is stated that “[o]ne would have been motivated to provide the selection capabilities to provide quick access to the program” (page 7); however, this rationale, as before, is so general that it could be applied to just about any reference, and has no application to the specific technical considerations of the present application.

Paragraph [0041] of the application as originally filed reads, in part, “[f]urther, the user may select one of the headings shown to launch or switch the display to a menu screen for the associated application.” Claims 9 and 18 read, in part, “enabling a user to launch the message application associated with one of the communications channels by selecting one of the displayed sub-list headings”. It therefore appears that the motivation identified by the Examiner for combining Schnarel with Schmidt, Jr. and Gidwani is taken from the Applicants’ own disclosure. Once again, this is improper; and accordingly, the Applicants submit that no *prima facie* case of obviousness has been made out for similar reasons as those set out in respect of claims 3, 4, 12 and 13.

No new subject matter has been added by this amendment. Having regard to the above submissions, favorable reconsideration and allowance of this application are respectfully requested.

This response is accompanied by a Petition for a one month extension of time. The Commissioner is authorized to charge any required fees, including the RCE fee set forth in 37 CFR 1.17(e), to our Deposit Account No. 500663.

Executed at Toronto, Ontario, Canada, on March 28, 2008.

GERHARD D. KLASSEN, CHRIS
WORMALD AND DAVID YACH



Jenna L. Wilson
Registration No. 54908
(416) 971-7202, Ext. 290
~~Customer Number: 38735~~

JLW:lf
Att: Petition for Extension of Time